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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,178	11/09/2001	Derrick J. Dimone	F-7905 PCT	4849

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LERNER AND GREENBERG, P.A.
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EXAMINER

BLACKWELL RUDASIL, GWENDOLYN A

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040218

Application Number: 10/036,178
Filing Date: November 09, 2001
Appellant(s): DIMONE, DERRICK J.

MAILED
FEB 25 2004
GROUP 1700

Loren D. Pearson
For Appellant

EXAMINER'S ANSWER

Art Unit: 1775

This is in response to the appeal brief filed 15 December 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-5 and 7-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 1775

(9) Prior Art of Record

4,801,479	FIELDER et al	1-1989
5,549,940	NOONE	8-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 and 7-14 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 6.

(11) Response to Argument

Applicant's arguments filed 15 December 2003 have been fully considered but they are not persuasive. Applicant contends that neither Fielder et al nor Noone teach or suggest a decoration that is a filler material that is shaped to complement and decorate an automobile insignia. Applicant also contends that while the insignia and the material of the filler may be old, the combination of the two creates a new overall combined decoration that relies on qualities from the insignia and the filler that is not suggested in the prior art.

Fielder et al disclose that it is known in the art to use various items such as trim strips, decorative articles and emblems to decorate and protect automobile body surface, (Fielder, column 1, lines 19-22). Fielder et al also disclose the structure of the decorative article as claimed by Applicant.

Noone demonstrates that it is known in the art to customize an automobile by using materials that are provided either in a standard size or a size that is trimmed to fit by the consumer, (Noone, column 5, lines 24-26). Noone also discloses different means for attaching the decoration to the automobile surface, (Noone, column 5, lines 28-33).

Art Unit: 1775

Fielder et al and Noone are analogous inventions that relate to the decoration of automobiles. Because Fielder et al and Noone disclose inventions used to decorate automobiles, it would have been obvious to one skilled in the art at the time of invention to modify the decorative material of Fielder et al with the attachment means of Noone to obtain a decorative material that adheres directly to the surface of the automobile without permanently damaging the surface of the automobile. It would also be within the skill of one in the art to trim the decorative material of Fielder et al to a desired shape as evidenced by the Noone reference that further discloses that decorative materials can be trimmed to a desired size, (Noone, column 5, lines 24-26).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Fielder et al and Noone disclose inventions utilized to decorate automobiles. Fielder et al further disclose that it is known to decorate automobile surfaces with decorative materials and emblems, (Fielder, column 1, lines 19-22). Noone sets forth different means to attach decorative materials to automobile surfaces, (Noone, column 5, lines 28-33). Noone also demonstrates that materials used to decorate automobiles can be either standard sized and ready to apply or the decorative material needs to be trimmed by the consumer to the desired shape, such as a hubcap, (Noone, column 5, lines 24-26).

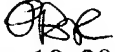
Art Unit: 1775

Because Fielder et al and Noone disclose decorative articles for use in customizing an automobile surface it would have been obvious to one skilled in the art at the time of invention to modify the decorative material of Fielder et al with the attachment means to attach the decoration to the surface of the automobile without damaging the surface. Based upon the type and placement of the decoration, it would have been obvious to one skilled in the art to further modify the decorative material of Fielder et al by trimming the excess decorative material, as taught by Noone, to take the desired shape.

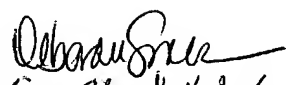
For the above reasons, it is believed that the rejections should be sustained.

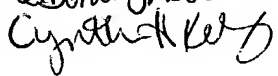
Respectfully submitted,

Gwendolyn A. Blackwell-Rudasill
Examiner
Art Unit 1775

GBR 
February 18, 2004

Conferees:

Deborah Jones 

Cynthia Kelly 

LERNER AND GREENBERG, P.A.
POST OFFICE BOX 2480
HOLLYWOOD, FL 33022-2480